

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/800,997 Confirmation No.: 6654
Applicant : Torget et. al.
Filed : March 8, 2001
Title : Systems and Methods for Remotely Generating Instruments
TC/Art Unit : 3621
Examiner: : Kambiz Abdi

Docket No. : 47004.000107
Customer No. : 21967

DECLARATION OF KEVIN P. WATTERS UNDER 37 C.F.R. § 1.131

I, Kevin P. Watters, declare:

1. I am over twenty-one years of age and make this Declaration in support of the above-captioned application.
2. I am currently an employee of J. P. Morgan Chase Bank, N.A., f/k/a Bank One Delaware, N.A., f/k/a First USA Bank, N.A. I began working at First USA Bank in 1999. My present position is Senior Vice President, Head of Corporate Internet Group. During the last half of 1999 and during 2000, my position was Senior Vice President of Marketing for Wingspanbank.com.
3. I understand that in the November 19, 2004 Office Action issued for this application, certain claims of this application were rejected under 35 U.S.C. §102(a) in view of a published patent application no. EP 1-014-318 A2 to Takashi Yamaguchi. I have reviewed the Yamaguchi reference. I have been informed that "conception" of an invention means the mental part of the inventive act. I also have been informed that a "constructive reduction to practice" of an invention occurs when a patent application on the claimed invention is filed.
4. Prior to June 28, 2000, the publication date of the Yamaguchi reference, I personally conceived, as I understand that term, the invention claimed and disclosed in claims 1-3, 10-11, 15-16, 18-20, 25, 27 and 66 of the present application, specifically, a method of remotely generating an instrument, such as a monetary instrument, including generating an image in electronic form and adding a security image to form a composite image.

Appl. No. 09/800,997
Declaration of Kevin Watters

5. During the last quarter of 1999, my primary job function was to handle daily operations and develop new products for an Internet bank called Wingspan. Wingspan was one of the first banks purely accessible from the Internet and therefore nearly all operations and products had to be developed specifically for this project.

6. In early November, 1999, I along with a number of fellow employees working on the Wingspan bank project attended an "idea generating" retreat at the Eureka! Ranch in Cincinnati, Ohio. We concentrated on developing new products to provide to Wingspan customers over the Internet to provide services those customers would typically get from a local branch of a "bricks and mortar" bank.

7. Two of those ideas were "mirror images" of each other. One involved a system and method for customers to deposit physical checks into Wingspan bank from their home, using home computing products, without the need to travel to or mail the check to the bank. The mirror image of that problem, as we saw it, was a system and method for customers to "print money" (i.e., print monetary instruments such as cashier's checks and traveler's checks) at home using home computing equipment, without the need to travel to the bank or receive the checks by mail from the bank.

8. The first idea was coined "Deposit@Home" and the second idea was coined "Printing Money@Home," or also "WingMoney."

9. Wingspan first pursued the "Deposit@Home" project as we felt that this offered a more widely needed service to our customers. A patent application was prepared and filed for that project on February 18, 2000. The application is still pending and has serial number 09/506,434.

10. Around the time the Deposit@Home patent application was filed, then-CEO of Bank One decided to sell Wingspan. During the first quarter of 2000, my time was greatly consumed with preparing and making pitches to potential buyers, and assisting with due diligence requests. I was also still responsible for the ongoing operations of Wingspan.

11. We attended a second session at the Eureka! Ranch on March 9-10, 2000 where we continued to develop the "Printing Money@Home" (or "WingMoney") idea.

12. In or around April 2000, a new CEO joined Bank One and he decided that Wingspan was

Appl. No. 09/800,997
Declaration of Kevin Watters

not to be sold. Once the sale of Wingspan was called off, we had more time to develop new projects for Wingspan.

13. Our department held regular meetings during the first half of 2000 to update progress on our many projects, including "Printing Money@Home." The meetings typically were held on a monthly basis, and often on a weekly basis.

14. Our primary push on "Printing Money@Home" in the spring and summer of 2000 was to locate vendors to see if they could provide the technical equipment that would be needed to print money at home, according to my idea.

15. The vendors that we contacted in the months of April, May and June of 2000 included IBM; RDM; Intuit; and Microsoft.

16. In July 2000, my co-inventor John Torget joined First USA in the position of Vice President of Marketing. One of his responsibilities was to take over development of "Printing Money@Home."

17. John Torget arranged a meeting with IBM that was held on August 23, 2000 regarding technical equipment that they offered that could be developed for the "Printing Money@Home" project.

18. John Torget summarized his meeting with IBM in an email circulated on August 24, 2000. IBM followed up with a written proposal of their ability to assist on the "Printing Money@Home" project on August 28, 2000. From August 2000 through early 2001, John Torget worked with IBM to adapt the IBM technology to carry out our ideas. This included adaptation of cryptography equipment as well as adaptation of special paper for printing the monetary instruments at the customer's location using the customer's computing equipment.

19. By September 2000, Dr. Bill Mann took the position of First Vice President of First USA Bank in charge of Patent Business Development. Dr. Mann held monthly meetings with inventors to follow the status of project development. Dr. Mann held a meeting on September 21, 2000 to discuss the "Printing Money@Home" project and to begin the process of gathering information to prepare a patent application for this invention.

Appl. No. 09/800,997
Declaration of Kevin Watters

20. On October 30, 2000, we contacted patent counsel at Hunton & Williams LLP to draft and file a patent application for the "Printing Money@Home" idea, naming me and John Torget as co-inventors.

21. A first draft of a provisional patent application was circulated for comment on November 28, 2000.

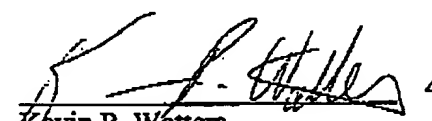
22. A provisional patent application was filed on December 1, 2000 and was assigned serial no. 60/250,127.

23. The present application was filed on March 8, 2001 and claimed priority to provisional application serial no. 60/250,127 filed on December 1, 2000.

24. According to my understanding of the term "constructive reduction to practice," the filing of provisional patent application serial no. 60/250,127 constitutes a constructive reduction to practice of the invention claimed in claims 1-3, 10-11, 15-16, 18-20, 25, 27 and 66.

25. I further declare that all statements made herein are based on personal knowledge or upon information and belief and are believed to be true; and further that the statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing thereon.

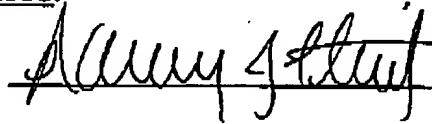
4/4/05
Date


Kevin P. Watters
Senior Vice President, Head of Corporate
Internet Group
J.P. Morgan Chase Bank, N.A., f/k/a Bank
One Delaware, N.A., f/k/a First USA Bank,
N.A.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile
transmitted to the Patent and Trademark Office
on April 7, 2005.



Signature

Nancy J. Flint

Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of transmission, or this
certificate must identify each submitted paper.

1. Response to Office Action dated November 19, 2004 for U.S. Patent
Application Ser. No. 09/800,997 4 pages.
2. Declaration of Kevin P. Watters pursuant to 37 C.F.R. § 1.131 4 pages
3. Fee Transmittal for Two Month Extension of Time plus duplicate 2 pages
4. Certificate of Fax Transmission 1 page
5. Fax Cover Sheet, 1 page